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Filing date: **10/21/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92064531
Party	Plaintiff National Tobacco Company, L.P.
Correspondence Address	AMY B BERGE MIDDLETON REUTLINGER 401 SOUTH 4TH ST STE 2600 LOUISVILLE, KY 40202 UNITED STATES aberge@middletonlaw.com, jdages@middletonlaw.com
Submission	Other Motions/Papers
Filer's Name	Amy B. Berge
Filer's e-mail	aberge@middletonlaw.com, jdages@middletonlaw.com
Signature	/Amy B. Berge/
Date	10/21/2016
Attachments	Notice of Returned Service Copy.pdf(881810 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of U.S. Registration No. 4,034,632

Mark: BIG BAG

Registration Date: October 4, 2011

NATIONAL TOBACCO COMPANY, L.P.)

Petitioner)

v.)

Cancellation No. 92064531)

YELLOWSTONE TOBACCO CO., LLC)

Respondent)

FILED VIA ESTTA

Trademark Trial and Appeal Board
P.O. Box 1451
Arlington, Virginia 22313-1451

NOTICE OF RETURNED SERVICE COPY AS UNDELIVERABLE

On October 3, 2016, Petitioner, National Tobacco Company, L.P. ("Petitioner"), filed its Petition for Cancellation of Registration No. 4,034,632 for the mark "BIG BAG" (the "Petition") with the Trademark Trial and Appeal Board (the "Board"), and served, via U.S. first-class mail, a copy of the Petition on the Registrant identified on the Trademark Status & Document Retrieval (TSDR) system of the United States Patent & Trademark Office ("USPTO"), that being Yellowstone Tobacco Co., LLC, at the address shown on the TSDR system as the owner of record's address, namely, P.O. Box 179, 507 N. Ash, Frannie, Wyoming 82423.

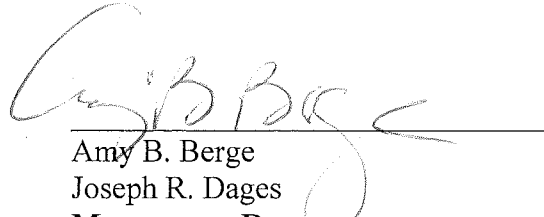
On October 12, 2016, the service copy of the Petition was returned to the undersigned counsel for Petitioner as “not deliverable as addressed” “unable to forward.” A copy of the service copy, along with the “return to sender” notification is attached hereto as Exhibit A.

Pursuant to TBMP §309.02(c)(2), Petitioner is now notifying the Board that the service copy has been returned as undeliverable and requests the Board to effect service so that the proceedings may be allowed to move forward.

However, Petitioner also wishes to notify the Board of its other attempts to notify the Registrant of the Petition. In addition to service of the Petition as set forth above, Petitioner, through counsel, emailed a copy of the Petition to the Registrant on October 3, 2016 at the email address shown on the TSDR system as the owner of record’s email address, namely, paperspro@gmail.com. A copy of such email correspondence is attached hereto as Exhibit B.

Subsequent to that email correspondence, Petitioner’s counsel spoke with Mr. Jason Dixon (who Petitioner believes upon information and belief to be a manager, as well as the registered agent, of the Registrant entity) by phone on or about October 17, 2016, and during such discussion Petitioner’s counsel notified Mr. Dixon of the Petition.

Respectfully submitted,



Amy B. Berge

Joseph R. Dages

MIDDLETON REUTLINGER

401 S. Fourth Street, Suite 2600

Louisville, Kentucky 40202

Telephone: (502) 584-1135

Direct: (502) 625-2887

Fax: (502) 588-1987

aberge@middletonlaw.com

Counsel for Petitioner

Dated: October 21, 2016

I HEREBY CERTIFY THAT THIS CORRESPONDENCE
IS BEING TRANSMITTED ELECTRONICALLY TO THE
TRADEMARK TRIAL AND APPEAL BOARD, UNITED
STATES PATENT AND TRADEMARK OFFICE, VIA THE
ESTTA SYSTEM, THIS 21ST DAY OF OCTOBER, 2016.

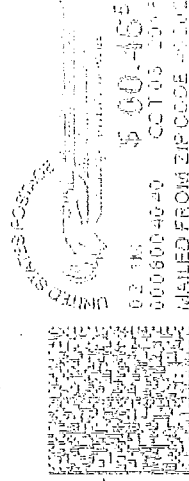
/AMY B. BERGE/

Exhibit A

MIDDLETON
REUTLINGER

401 South Fourth Street
Suite 2600
Louisville, Kentucky
40202

Yellowstone Tobacco Co.
P.O. Box 179
507 N. Ash
Frankie, Wj



NIXIE 888. FE 1 8818/12/18

RETURN TO SENDER
NOT DELIVERABLE AS ADDRESSED
UNABLE TO FORWARD

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482625468
BC: 80282446830 *8878-88841-88-42

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Cancellation No. _____

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P.O. Box 1451
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PETITION FOR CANCELLATION

Pursuant to Section 1064 of Title 15, United States Code, Petitioner, National Tobacco Company, L.P., believes that it will be damaged by continued registration of Registration No. 4,034,632 for the mark "BIG BAG" [standard characters] (the "Registration") in International Class 034 for "Cigarette paper; Cigarette papers; Cigarette rolling machines; Cigarette rolling papers; Cigarette tubes; Cigarettes," and hereby petitions to cancel said Registration. Petitioner alleges, as grounds for this petition, as follows:

1. Petitioner, National Tobacco Company, L.P., is a limited partnership organized and existing under the laws of Delaware, with a mailing address of 5201 Interchange Way, Louisville, Kentucky 40229.

2. To the best of Petitioner's knowledge, the name and address of the owner of the Registration ("Respondent") are as listed on the records of the Trademark Office, namely, Yellowstone Tobacco Co., LLC, a Wyoming limited liability company, P.O. Box 179, 507 N. Ash, Frannie, Wyoming 82423.

3. Petitioner adopted and has continuously use the mark BIG BAG BIG SAVINGS in connection with the following goods since at least as early as June 13, 2007, as set forth in its pending application Serial No. 86/815,098: "Chewing tobacco; Smokeless Tobacco" in Class 034.

4. Registration No. 4,034,632, sought to be cancelled, is for the mark BIG BAG, presently registered for "Cigarette paper; Cigarette papers; Cigarette rolling machines; Cigarette rolling papers; Cigarette tubes; Cigarettes."

5. The Trademark Office has issued a final refusal of registration for the mark of Petitioner's pending application Serial No. 86/815,098 pursuant to Section 2(d) of the Lanham Act [15 U.S.C. § 1052(d)], on the grounds of alleged likelihood of confusion with the Registration.

6. Without cancellation of the Registration, Petitioner might not be able to establish the *prima facie* exclusive right to use the mark BIG BAG BIG SAVINGS on its applied-for goods, which would be to the detriment of Petitioner.

7. To the extent, that Petitioner's mark is sufficiently related to cause confusion with the mark of Registration No. 4,034,632, as the trademark examining attorney contends, the continued registration of the Registration would be to the great detriment of Petitioner.

8. Upon information and belief, Respondent has no rights in the registered mark BIG BAG prior to February 2, 2010 -- the first use date in commerce that is set forth in the Registration, which is over two years after Petitioner's first use date in commerce. Therefore, to the extent the respective marks of the parties (when used with the parties' respective goods) are sufficiently related to cause confusion, as the trademark examining attorney contends, Petitioner, and not Respondent, has priority of use and is entitled to registration.

9. If the Registration is allowed to subsist on the Principal Register, a cloud may be placed on Petitioner's ability to establish title in and to the mark BIG BAG BIG SAVINGS, and on its right to enjoy the free and exclusive use thereof in connection with the goods with which Petitioner uses the mark, all to the great injury of Petitioner.

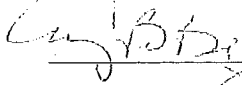
WHEREFORE, Petitioner alleges that it is or will be damaged by the continued registration of Registration No. 4,034,632, and petitions for cancellation thereof.

Petitioner hereby appoints the undersigned counsel and the law firm MIDDLETON REUTLINGER, 401 South Fourth Street, Suite 2600, Louisville, Kentucky 40202, (502) 584-1135, as its attorney with full power of substitution and revocation, to prosecute this cancellation proceeding, and to transact all business in the Trademark Office in connection therewith.

The filing fee required in Section 2.6(a)(16) is submitted herewith (\$300.00 per class).

Respectfully submitted,

Dated: October 3rd, 2016

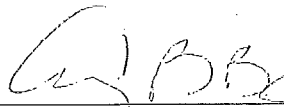


Amy B. Berge
Joseph R. Dages
MIDDLETON REUTLINGER
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Louisville, Kentucky 40202
Telephone: (502) 584-1135
Direct: (502) 625-2887
Facsimile: (502) 588-1987
Email: aberge@middletonlaw.com
Counsel for Petitioner,
National Tobacco Company, L.P.

PROOF OF SERVICE PURSUANT TO 37 C.F.R. §§ 2.111 & 2.119

The undersigned hereby certifies that the foregoing Petition for Cancellation was served, pursuant to 37 C.F.R. §§ 2.111 and 2.119, upon the following owner of record for the registration, at the following address, by transmitting the document via U.S. first class mail, postage prepaid, this 3rd day of October 2016:

Yellowstone Tobacco Co.
P.O. Box 179
507 N. Ash
Frannie, Wyoming 82423



Amy B. Berge
Counsel for Petitioner
National Tobacco Company, L.P.

Exhibit B

Joseph R. Dages

From: "Joseph R. Dages"
Sent: Monday, October 03, 2016 2:22 PM
To: paperspro@gmail.com
Subject: BIG BAG Trademark - National Tobacco Company, L.P.
Attachments: Petition for Cancellation - Yellowstone Tobacco Co., LLC - BIG BAG.PDF

Mr. Dixon,

As we discussed by phone last week, National Tobacco Company, L.P.'s trademark application is being refused registration by the Trademark Office due to a perceived conflict with Yellowstone Tobacco's trademark registration for the mark BIG BAG. In order to protect its interests, National Tobacco Company today filed a Petition for Cancellation against Yellowstone Tobacco's trademark registration. A copy of the Petition for Cancellation is attached, and the original copy is being sent to you via first class mail.

However, as we discussed, National Tobacco Company believes there is a path for resolving its concerns. To that end, it is preparing a proposal for settling any disputes it may have for Yellowstone's review and consideration, and we will provide that to you very soon. Assuming National Tobacco Company's concerns are resolved, it would be in a position to withdraw its Petition for Cancellation.

We will be in touch soon, but should you have any questions in the meantime, please do not hesitate to let us know. Also, if Yellowstone Tobacco engages an attorney to assist with this matter, please have him or her contact me so that I can communicate with your attorney directly.

Thank you,



Joe Dages
Attorney

Direct: 502.625.2865 Fax: 502.588.1965
401 South Fourth Street, Suite 2600, Louisville, KY 40202
jdages@middletonlaw.com

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Respectfully submitted,

Dated: October 3rd, 2016



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Counsel for Petitioner,
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Counsel for Petitioner
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